

REMARKS

The Office Action dated June 16, 2006, has been received and carefully considered. Reconsideration of the outstanding objections/rejections in the present application is respectfully requested based on the following remarks.

I. THE OBVIOUSNESS REJECTION OF CLAIMS 1-18, 20-24 AND 26-27

On page 2 of the Office Action, claims 1-18, 20-24 and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarter (U.S. Patent No. 5,550,734) or over Tarter in view of Field (U.S. Patent No. 6,073,104). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding claims 1-18, 20-24 and 26-27, the Examiner alleges that Tarter discloses a "computerized healthcare accounts receivable purchasing collections, securitization and management system and method." The Examiner also alleges that the system and method "comprise receiving data comprising an invoice with payable and receivable information from a first participant involved in a transaction and storing the information in a receivable clearinghouse and generating electronic invoice information in response to the invoice received from the first participant." The Examiner also alleges that "[t]he claimed participant being a

healthcare provider and the claimed receivable clearinghouse being the 'Pharmacy Fund, Inc.' (PFI) of the system of Tarter." The Examiner also alleges that "[s]ince the PFI obtains receivables, it would have been obvious to one of ordinary skill in the art that the receivables were offered for sale to third parties over a receivable marketplace associated with the receivable clearinghouse or PFI [the System Operator] wherein the receivable marketplace being accessed by a receivable trading apparatus." The Examiner also alleges that "[i]n any event, Field discloses a system and method for facilitating the selling and purchasing of a receivable."

However, Applicant respectfully submits that neither Tarter nor Field -- alone or in combination -- teaches or suggests any feature or functionality comprising the step of "offering the receivable for sale to third parties over a receivable marketplace associated with the receivable clearinghouse, the receivable marketplace being accessed by a receivable trading apparatus," as expressly recited in independent claim 1.

Regarding Tarter, Applicant respectfully disagrees with the Examiner allegation that because the PFI obtained a receivable, it would have been obvious to one of ordinary skill in the art that the receivable was offered for sale to third parties over a receivable marketplace. In particular, Applicant respectfully submits that there is no teaching or suggestion in Tarter that any receivable is offered to *third parties*. Tarter merely discloses that only the PFI -- the operator of CHARMS -- can decide whether it wants to purchase a receivable. Accordingly, Applicant respectfully submits that Tarter fails to teach or suggest the specific step of "offering the receivable for sale to third parties over a receivable marketplace associated with the receivable clearinghouse, the receivable marketplace being accessed by a receivable trading apparatus," as expressly required by claim 1.

Similarly, Applicant respectfully submits that Field does not teach or suggest the specific step of “offering the receivable for sale to third parties over a receivable marketplace associated with the receivable clearinghouse, the receivable marketplace being accessed by a receivable trading apparatus.” Rather, Field merely teaches a computerized system that will allow healthcare providers to access the commercial paper market by selling their patient claims to asset backed commercial paper conduits. *See* Abstract, Filed patent. Applicant respectfully submits that the commercial paper market disclosed by Field is not “a receivable marketplace associated with the receivable clearinghouse,” as required by pending claim 1.

Further, Applicant respectfully submits that the Examiner has failed to set forth a proper motivation for combining Tarter and Field to achieve the claimed invention. In particular, Applicant respectfully submits that the Examiner has not demonstrated why one of ordinary skill in the art would be motivated to incorporate Field’s access to the commercial paper market with Tarter’s system and method that only enables the PFI to purchase receivables. Applicant respectfully submits that Tarter’s system and method for allowing a lone system operator (e.g., PFI) to purchase a receivable would not benefit from -- and indeed is incompatible with -- Field’s system and method for providing access to the commercial paper market.

Accordingly, for at least the reasons set forth above, Applicant respectfully submits that claim 1 is allowable over the cited references.

Regarding claims 14 and 20, these claims recite subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claims 14 and 20. Accordingly, it is respectfully submitted that claims 14 and 20 are allowable over Tarter and Field for the same reasons as set forth above with respect to claim 1.

Regarding claims 2-13, 15-18, 21-24 and 26-27, these claims are dependent upon

independent claim 1, 14 or 20. Thus, since independent claims 1, 14 and 20 should be allowable as discussed above, claims 2-13, 15-18, 21-24 and 26-27 should also be allowable at least by virtue of their dependency on independent claim 1, 14 or 20. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-18, 20-24 and 26-27 be withdrawn.

II. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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